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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,559	01/20/1999	SUNDARAM RAMAKESAVAN	INTL-0170-US	5930

21906 7590 02/23/2006

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EXAMINER

KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/234,559	Applicant(s) RAMAKESAVAN, SUNDARAM	
	Examiner Victor R. Kostak	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/20/99 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/07/05; 09/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The drawings are objected to because block 44 in Fig. 2 is mislabeled. The only reference in the specification (page 7 lines 15 and 16) refers to block 44 as an “acknowledgement number” block. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. It is initially noted that the most recent listing of claims (i.e. in the appendix of the latest appeal brief) lists claims 1-26. However, the amendment of 08/03/00 specifies that claims 21, 22 and 24 have been canceled.

3. Upon review of the claims and the prosecution history, the following rejections are now presented

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20, 23, 25 and 26 are now rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment dated 06/26/00 in which language added to all six independent claims 1, 4, 10, 14, 16 and 17 covering the "automatic" requests, and the additional amendment to claims 10 and 14 (dated 08/03/00) is not covered by, nor can be derived from, the original disclosure. *Only* lines 11-22 on page 7 of the original specification addresses the pause/resume operation. *Nothing* in that text allows for any "automatic" operations. Subsequent to an initial pause request, an actual resumption is done by a *manual* prompting of a key, as expressly stated in the text on page 7, and the acknowledgement number (apparently the same as that sent with the pause authorization) is provided by the user with the resume request, which means that it too must be provided *manually*. *All* of the operations are therefore manually prompted by the user.

5. Claims 1-20, 23, 25 and 26 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As pointed out above, all of the six independent claims recite “...*automatically request(ing) a code to enable play to be resumed at a later time.*” It is not clear from the claim context, nor in light of the original disclosure, how the system can “automatically” request a code. In only one paragraph of the specification are the pause/resume operations discussed (lines 11-22 of page 7). The text therein does not describe any automatic requesting of any code, but only manual prompting. In fact, no mention of a code is even given.

Corresponding Fig. 2 correlates “request code” 42 with a “pause authorization” which one of ordinary skill in the art would understand as being a signal *manually* initiated by the user in the requesting of a pause (thereby giving the user full control of this function, at his desire).

Step 44 in Fig. 2, shown labeled as a “display code,” is expressly designated as an “acknowledgement number” in the specification. The original disclosure does not give any explanation what the “number” represents beyond the implied role of providing the user with an indication that the provider has acknowledged the pause (why any acknowledgment would be necessary to inform the user who prompted the pause, and would presumably visibly notice the pause, is not understood; unless the number is used to acknowledge something else, but that is not specified). As explained above, the subsequent and actual resumption is done by a *manual* prompting of a key, as expressly stated in the text on page 7, and the acknowledgement number (apparently the same as that sent with the pause authorization) is provided by the user with the resume request, which means that it too must be provided *manually*.

In view of all of this, the claims as amended to include an “automatic” request is not clarified by the original disclosure, so relying therefore only on the claim language, the claims are accordingly misdescriptive and are indefinite in scope because how an “automatic” request is carried out is not understood nor explained as delimited by the claims.

The additional amendment to claim 10 (dated 08/03/00) in which an “acknowledgement code” is recited is also ambiguous if not misdescriptive because the specification only refers to an acknowledgment *number* which is implied therein as an acknowledgment of a pause. The user in turn sends a resume request and the acknowledgement number with the request to restart the play. The claim instead appears to require the acknowledgment “code” (rather than any actual resume prompt) to resume play.

Independent claim 14 also has additional misdescriptive claim language added in the amendment dated 08/03/00. The amended claim language therein is misdescriptive because the controller (provider) cannot “automatically” provide the “code” (i.e. the acknowledgement number, so implied by the specification), because it must react to a prompting by the user.

Because applicant does not describe any actual “automatic” resumption of play based on any codes (so claimed in all six independent claims) and instead defines his invention by indefinite terms as explained above, then he has not provided any guidance to one of ordinary skill in the art how to make and use his claimed invention, though his original disclosure.

Pointing these errors out is not a minor matter, in view of the Board’s latest decision wherein it was decided that the difference between the prior art and applicant’s claimed invention hinges on “automatic” operations actually being used or not. In light of the fact that both the appellant argued that Dan likely uses manual requests, and the acknowledgment by the

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Board of that in fact, now allows the combination of Dan and Saward to be applied against applicant's actual system described in his original disclosure.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The newly-cited reference to Dan is related to Dan (of record), and expressly points out that the client requests including stop, resume and pause functions are processed by video player 230 which is embodied as program code and data structures instantiated in the memory of the video server (col. 3 lines 32-39).

7. Claims 1-20, 23, 25 and 26 are allowable over the prior art *only* because the *claimed* invention is not disclosed nor suggested. However, the applicant is herein informed that were the system claimed in accordance with how it is actually described in the original disclosure, it would be rejected based on the art of record.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is (571) 272-7348. The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Or faxed to:

(571) 273-8300

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office whose telephone number is (703) 308-HELP.



Victor R. Kostak
Primary Examiner
Art Unit 2614

VRK



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DIRECTOR
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